

REMARKS/ARGUMENT

Claims 6-11 are currently pending. Claims 6-8 and 10 have been amended to eliminate a possible ambiguity in the original terminology ("rigid" has been changed to - - non-resilient - -). Claim 6 has been amended in addition to point out more clearly the ways in which the invention differs from the prior art, and particularly Widnall U.S. Patent 3,122,269 and Deane et al. British Patent 401,955. It should be noted that these differentiating features were recited in claim 6 as originally presented, and accordingly, the scope of this claim is not considered to have been changed by the present amendment.

It is respectfully submitted that the subject matter of claim 6 is not obvious over the combination of cited references, because the references can not legitimately be combined, and even if the references are combined, the resulting structure is not the same as that claimed.

In particular, claim 6 as amended is directed to a golf swing training device *usable with diverse golf clubs*. The device is generally comprised of:

a golf ball;

a non-resilient line wherein a first end of said non-resilient line is secured to said golf ball and a second end of said non-resilient line is anchored to the ground at a predetermined distance in front of said golf ball;

a resilient line that is transverse to said non-resilient line and approximately bisected by said non-resilient line, said resilient line has both a first end and a second end anchored to the ground;

a ring that encloses said non-resilient line and said resilient line, wherein said ring is slidable along said non-resilient line and said ring is slidable along said resilient line; and

a plurality of indicators located on said non-resilient line . . .

The Examiner's position is that Deane et al. show every feature of the claim except the "a plurality of indicators located on said [non-resilient] line", which he says, however is found in Widnall. He justifies combining the references on the basis of use of fewer components and cost reduction, and he dismisses what he calls "phrases . . . directed to the intended manner of use" as

irrelevant in distinguishing the claimed structure over the same structure in the prior art having a different use.

With all due respect, the Examiner is incorrect in respect to each of the above points. In particular, Deane et al. do show indicia on the non-resilient line to show the distance of the drive (see, for example, page 3, lines 99-111). Conversely, Widnall does show distance indicators, but these are on an *elastic* line, not a non-resilient line.

It would not be obvious to combine these two references. Widnall teaches a single plastic line anchored at several locations with integral distance indicators, while Deane et al. teach two separate lines with a distance indicator movably coacting with the non-resilient line. The relatively movable distance indicator structure of Widnall would not work with the non-resilient and resilient lines of Deane et al.

Even if the references are combined, however, the resulting structure does not meet the terms of claim 6. Claim 6 further specifies that:

each indicator [represents] a location at which said resilient line is to cross said non-resilient line when the first and second ends of said resilient line are anchored to the ground for correct operation of the device with a particular type of a golf club.

There are at least two reasons that claim 6 is distinguishable over the Deane et al. and Widnall patents, either alone or in combination. First, claim 6 is concerned with the combination of a structure and an integral set of indicator marks which interact with the recited structure to allow proper setup of the device for use with diverse golf clubs. This structural feature is recited in both the claim preamble and in the body of the claim. A recitation in a claim preamble must be treated as a structural limitation when it is necessary to give life, meaning, and vitality to the claim. See, M.P.E.P. 2111.02, *Kropa v. Robie et al.*, 88 U.S.P.Q. 478, 480-481 (CCPA 1951).

Neither reference, alone or in combination, teaches a device designed to be set up differently for use with different clubs. When proper weight is given to the preamble, it is clear that claim 6 is allowable over these references.

Secondly, the body of claim 6 explicitly recites that the indicators establish a desired relationship between the anchoring positions of the two ends of the resilient line and the crossing point of the resilient and non-resilient lines so the device will operate correctly for different clubs.

As explained above, the indicia taught by the references are to show a simulation of the travel distance of the ball, not for setting up the device for use with different clubs. Thus, the interaction between the indicia and the remainder of the structure as recited in claim 6 is both novel and unobvious compared to the prior art. The Examiner must give full structural significance to such claimed interaction. See *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q. 2d 1031 (CAFC 1994); *In re Gulack*, 703 F. 2d 1381, 217 U.S.P.Q. 401 (CAFC 1983); *In re Miller*, 418 F.2d 139, 164 U.S.P.Q. 46 (CCPA 1969). Claim 6 is patentable for this additional reason.

Claims 7-11 are directly or indirectly dependent on claim 6, and are therefore patentable for the reasons stated above. In addition, these claim recite features which, in combination with the features of their respective parent claims are neither taught nor suggested in the Deane et al. and Widnall patents.

In view of the foregoing, favorable reconsideration and allowance of this application are respectfully solicited.

I hereby certify that this correspondence is being transmitted via facsimile to (703) 746-3204 addressed to: Asst. Commissioner for Patents, Washington, D.C. 20231, BOX A-F, on December 17, 2002:

Respectfully submitted,

Lawrence A Hoffman
Name of applicant, assignee or
Registered Representative

Lawrence A Hoffman
Signature

December 17, 2002
Date of Signature

LAH:sam

Lawrence A Hoffman
Lawrence A Hoffman
Registration No.: 22,436
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone: (212) 382-0700

APPENDIX A
"CLEAN" VERSION OF EACH PARAGRAPH/SECTION/CLAIM
37 C.F.R. § 1.121(b)(ii) AND (c)(I)

SPECIFICATION:

NO CHANGES

CLAIMS (with indication of amended or new):

6. (Amended) A golf swing training device usable with diverse golf clubs comprising:
- a golf ball;
 - a non-resilient line wherein a first end of said non-resilient line is secured to said golf ball and a second end of said non-resilient line is anchored to the ground at a predetermined distance in front of said golf ball;
 - a resilient line that is transverse to said non-resilient line and approximately bisected by said non-resilient line, said resilient line has both a first end and a second end anchored to the ground;
 - a ring that encloses said non-resilient line and said resilient line, wherein said ring is slidable along said non-resilient line and said ring is slidable along said resilient line; and
 - a plurality of indicators located on said non-resilient line each indicator representing a location at which said resilient line is to cross said non-resilient line when the first and second ends of said resilient line are anchored to the ground for correct operation of the device with a particular type of a golf club.
7. (Amended) The golf swing training device of claim 6, wherein a length of said non-resilient line is approximately seven meters and a length of said resilient line is approximately five meters.
8. (Amended) The golf swing training device of claim 6, wherein said non-resilient line is secured to said golf ball by an expansion means or a holding ring that is coupled to a corrugated fastener member located at a core of said golf ball.
10. (Amended) The golf swing training device of claim 6, wherein said non-resilient line is secured to said golf ball by a vulcanization process.

APPENDIX B

VERSION WITH MARKINGS TO SHOW CHANGES MADE

37 C.F.R. § 1.121(b)(iii) AND (c)(ii)

SPECIFICATION:

NO CHANGES

CLAIMS:

6. (Amended) A golf swing training device usable with diverse golf clubs comprising:

a golf ball;

a [rigid] non-resilient line wherein a first end of said [rigid] non-resilient line is secured to said golf ball and a second end of said [rigid] non-resilient line is anchored to the ground at a predetermined distance in front of said golf ball;

a resilient line that is transverse to said [rigid] non-resilient line and approximately bisected by said [rigid] non-resilient line, said resilient line has both a first end and a second end anchored to the ground;

a ring that encloses said [rigid] non-resilient line and said resilient line, wherein said ring is slidable along said [rigid] non-resilient line and said ring is slidable along said resilient line; and

a plurality of [marks] indicators located on said [rigid] non-resilient line each indicator representing a location at which [wherein a mark indicates a reference point for] said resilient line [to transverse] is to cross said [rigid] non-resilient line when the first and second ends of said resilient line are anchored to the ground for correct operation of the device with a particular [and said mark indicates a] type of a golf club[for a player to use when said resilient line crosses said [rigid] non-resilient line at said mark]

7. (Amended) The golf swing training device of claim 6, wherein a length of said [rigid] non-resilient line is approximately seven meters and a length of said resilient line is approximately five meters.

8. (Amended) The golf swing training device of claim 6, wherein said [rigid] non-resilient line is secured to said golf ball by an expansion means or a holding ring that is coupled to a corrugated fastener member located at a core of said golf ball.

10. (Amended) The golf swing training device of claim 6, wherein said [rigid] non-resilient line is secured to said golf ball by a vulcanization process.